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| APPLICATION NO.                   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------|-------------|----------------------|---------------------|------------------|
| 09/994,872                        | 11/28/2001  | Tsunehiro Tsukada    | 35.G2941            | 9796             |
| 5514                              | 7590        | 10/10/2007           | EXAMINER            |                  |
| FITZPATRICK CELLA HARPER & SCINTO |             |                      | HANG, VU B          |                  |
| 30 ROCKEFELLER PLAZA              |             |                      | ART UNIT            | PAPER NUMBER     |
| NEW YORK, NY 10112                |             |                      | 2625                |                  |
|                                   |             |                      | MAIL DATE           | DELIVERY MODE    |
|                                   |             |                      | 10/10/2007          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/994,872             | TSUKADA, TSUNEHIRO  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Vu B. Hang             | 2625                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 September 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6-9,11-14,21-24 and 26-30 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1-4,6-9,11-14 and 21-24 is/are allowed.  
 6) Claim(s) 26-30 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/28/2005, 02/20/2002</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

- This office action is responsive to the Request for Continued Examination filed on 09/20/2007.
- The amendments received on 09/20/2007 have been entered and made of record.
- Claims 5, 10, 15-20 and 25 are cancelled.
- Claims 1-4, 6-9, 11-14, 21-24 and 26-30 are pending in the application.

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 26-30** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows:

3. Claims 26-30 define a computer program. A computer program is not a “machine”, “composition of matter” or a “manufacture” because these statutory classes relate to structural entities and can be grouped as “product” claims in order to contrast with “process” claims (1D. Chisum, Patents §1.02 (1994)). Machines, manufactures and compositions of matter are embodied by physical structures or material, whereas “computer programs” are not “machines” because they have no physical structures, and do not perform any useful, concrete and tangible results. Likewise, computer programs are not compositions of matter because they are not matter, but rather a form of conceptual idea. Finally, computer programs are not “manufactures” because all traditional definitions of a manufacture have required some form of physical structure, which the claimed computer program do not have.

A "manufacture" is defined as "the production of articles for use from raw materials or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand-labor or by machinery." *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8, USPQ 131, 133 (1931)).

4. Therefore, a computer program is considered non-stutory because it is a form of conceptual idea, in the absence of any physical structure or tangible material, that does not fall within any of the four statutory classes of 35 U.S.C. §101.

***Allowable Subject Matter***

5. **Claims 1-4, 6-9, 11-14 and 21-24** are allowed.
6. The following is an examiner's statement of reasons for allowance:

The prior art of record does not teach, disclose or suggest the claimed limitations of (in combination with all other limitations in the claim), an "information processing apparatus comprising: a receiving unit adapted to receive a request and template data including a reusable object, an index of a variable object and position data of the variable object from an external apparatus; a generation unit adapted to generate, in response to a received request from the external apparatus, print data corresponding to a preview displayed on a display screen on the external apparatus, wherein the generation unit generates print data by merging the reusable object in the template data and the variable object by using the reusable object, the index of the variable object and the position data of the variable object in the template data, and wherein the index of the variable object is extracted from the template data and the index of the variable object from the template data is used during the merging process; a selecting unit adapted to select a print server to transmit the generated print data from plural print servers, wherein the

print server is selected in accordance with the external apparatus; an obtaining unit adapted to obtain instructions for printing via the display screen on the external apparatus; and a transmission control unit adapted to control transmission so that the print data generated by the generation unit is transmitted to a print server selected by the selecting unit in response to the obtaining unit for obtaining instructions for printing”, as claimed in **Claim 1**. Similar features are claimed in Claims 2-4, 6-9, 11-14 and 21-24. Therefore, **Claims 2-4, 6-9, 11-14 and 21-24** are allowable over the prior art of record for the same reasons.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.
8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

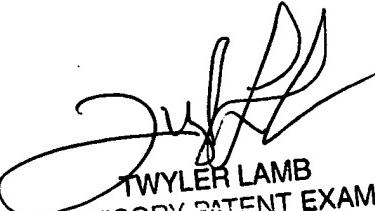
*Vu Hang*

Art Unit: 2625

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang  
Assistant Examiner

Vu Hang



TWYLER LAMB  
SUPERVISORY PATENT EXAMINER